

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

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UNITED STATES PATENT AND TRADEMARK OFFICE

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY RAYMOND HEINDEL, TIM JOSEPH JANSSEN, SCOTT LEE
PENNING, GARY MACK REYNOLDS, PAUL JOHN SERBIAK, BRUCE MICHAEL
SIEBERS, ROBERT EUGENE VOGT and GEORGIA LYNN ZEHNER

Appeal No. 2000-2185
Application No. 08/834,777

ON BRIEF

Before COHEN, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 35, 43, 44, 48 and 50-57, which are all of the claims pending in this application. Claims 35, 43, 44 and 48 were amended subsequent to the final rejection (see Paper No. 7).

BACKGROUND

The appellants' invention relates to a package of disposable absorbent articles, each article including, inter alia, at least

one hook-and-loop type mechanical fastener. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art reference of record in rejecting the appealed claims:

Roessler et al. (Roessler) 5,176,670 Jan. 5, 1993

The following rejections are before us for review.¹

Claims 35, 43, 48 and 50-57 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Roessler.

Claim 44 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Roessler.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 12) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 11) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied Roessler reference, and to the respective

¹ According to the examiner (Paper No. 8), the rejection of claims 43 and 44 under the second paragraph of 35 U.S.C. § 112 was overcome by the amendment of Paper No. 7.

positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Each of independent claims 35 and 48 recites a "package of disposable absorbent articles comprising a plurality of said disposable absorbent articles...." Roessler discloses a disposable diaper comprising a cover 11, a topsheet 21, an absorbent body 22 between the cover and topsheet, ear portions 17-20 and a hook and loop fastener including tabs 30 extending beyond the margin of ears 17, 18 with hook tab material 31. Roessler also discloses "an inactive storage" position in Figure 6, whereat the hook material lightly attaches to the nonwoven material of the topsheet 21 (column 6, lines 23-26). However, we

find no teaching in Roessler of a package of a plurality of such disposable diapers. With regard to this issue, the examiner asserts neither that Roessler expressly discloses such packaging of a plurality of disposable diapers nor that such packaging is inherent in Roessler. Rather, the examiner's only comment in this regard is that "packaging of disposable absorbent articles in multiples unit, prior to use, have been found to be generally well known knowledge by those ordinarily skilled in the art [sic]" (answer, page 5).² Such a statement, even if true, while perhaps pertinent in an obviousness assessment, is of no avail in an anticipation rejection.

Moreover, claim 48, and claims 50-57 which depend therefrom, recite that the stemlike projections of the plurality of disposable absorbent articles of the package are "releasably engaged with said disposable absorbent article to protect said hook material and provide a pant-like structure before said disposable absorbent article is packaged." We find no teaching in Roessler of engaging the hook material with the absorbent article so as to provide a pant-like structure prior to packaging. Roessler teaches forming the diaper into a pant-like

² Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991).

structure only upon application of the diaper on the infant (Figure 10). The examiner's implication on page 5 of the answer that the recitation in claim 48 with respect to engagement of the hook material to provide a pant-like structure is directed merely to intended use appears to lose sight of the fact that claim 48 is directed not to a disposable absorbent article but to a package comprising a plurality of disposable absorbent articles formed into a pant-like structure before packaging.

In light of the above, we conclude that Roessler does not disclose, either expressly or under the principles of inherency, each and every element of claim 35 or 48. Therefore, we shall not sustain the examiner's rejection of claims 35 and 48, or claims 43 and 50-57 which depend from claims 35 and 48, as being anticipated by Roessler.

The obviousness rejection

The disposable diaper of Roessler, discussed supra, comprises a hook and loop fastener including a tab 30 adhered to the ear portions of topsheet 21 and cover 11. As illustrated in Figure 6 and explained in column 6, lines 23-26, the tab 30 may be folded inwardly to an inactive storage position whereat the hook material 31 on the tab 30 lightly attaches to the nonwoven material of the topsheet 21.

The examiner concedes that Roessler does not disclose that the stemlike projections are releasably engaged with the elastic ear tab to provide a peel strength of from about 30 to about 90 grams as recited in claim 44, but urges that, in that appellants have not shown that the recited peel strength is critical, the claimed peel strength would have been a routine engineering choice to one skilled in the art. Appellants have not challenged the examiner's position with regard to the peel strength.

Appellants argue that Roessler fails to describe or suggest a package of disposable absorbent articles which include a hook-and-loop type mechanical fastener wherein the base of the hook material is attached to an elastic ear tab and the stemlike projections of the hook material are releasably engaged with the elastic ear tab to protect the stemlike projections before the article is packaged (brief, pages 5 and 7).

To the extent that appellants' position is that the ear portions 17, 18 of the topsheet 21 are not "elastic ear tabs" as recited in independent claim 35, we do not share their opinion. The portion of the topsheet 21 with which the hook material 31 is engaged in the storage position shown in Figure 6 is clearly part of one of the "ear portions" 17, 18, which we consider to be "ear tabs" as recited in appellants' claim 35, from which claim 44 depends. Moreover, contrary to appellants' argument on page 5 of

the brief, Roessler's topsheet 21 is disclosed as being either elastic or inelastic material (column 4, lines 40-42).

As for the recitation in claim 35, from which claim 44 depends, of a package comprising a plurality of absorbent articles, appellants do not contest the examiner's statement on page 5 of the answer that the packaging of multiple disposable absorbent articles was generally known to those skilled in the art at the time of appellants' invention. From our perspective, in view of the well known and conventional practice of packaging a plurality of disposable diapers in a single package, it would have been obvious to one skilled in the art to package a plurality of the disposable diapers of Roessler, in the storage position illustrated in Figure 6, in a single package for subsequent use by the consumer.

For the foregoing reasons, we are not persuaded by appellants' arguments that the examiner's conclusion that the subject matter of claim 44 would have been obvious to one of ordinary skill in the art at the time of appellants' invention in view of the teachings of Roessler is in error. Accordingly, we shall sustain the examiner's rejection of claim 44 under 35 U.S.C. § 103(a).

NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 35 and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Roessler in view of the conventional practice of packaging a plurality of disposable diapers in a single package.

Roessler, as discussed supra, discloses a disposable diaper comprising an outer cover 11, a bodyside liner (topsheet 21), an absorbent core (absorbent body 22) disposed between the cover and liner, a pair of elastic ear tabs (ear portions 17, 18 of the elastic topsheet 21 and stretchable cover 11) and at least one mechanical fastener. The mechanical fastener comprises a hook-and-loop type fastener including a hook material (stemlike projections) 31 extending from a base sheet (tab 30) attached to one of the ear tabs by adhesive part 30a and separate tape piece 32. The hook material 31 is releasably engaged ("lightly attaches") with the elastic ear tab 17 or 18 in a storage position to protect the hook material.

Roessler does not expressly disclose packaging of a plurality of the disclosed disposable diapers in a package. However, we take official notice of the well known and conventional practice of packaging a plurality of disposable

diapers in a single package at the time of appellants' invention.³ In light of this conventional practice, it would have been obvious to one skilled in the art at the time of appellants' invention to package a plurality of disposable diapers of the type disclosed by Roessler in the storage position illustrated in Figure 6 in a single package for subsequent sale and use by the consumer.

With regard to claim 43, which recites that the stemlike projections are releasably engaged with the elastic ear tab to provide a peel strength of at least about 20 grams, we note that Roessler discloses a peel force (presumably between the hook material 31 and the loop material swatch 35 facing outwardly from the face of the cover 11) of about 200-1200 grams per inch and a total peel resistance of at least about 400 grams, but does not specify the peel strength between the hook material 31 and the ear portion of the topsheet 21 in the storage position illustrated in Figure 6, other than to indicate that the hook material "lightly attaches" to the topsheet 21. In any event, as

³ As discussed supra, appellants have not contested the examiner's statement on page 5 of the answer that such practice was well known in the art.

stated in In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990):

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range [citations omitted].

In the present case, however, appellants have not even alleged, much less established, that the claimed peel strength produces unexpected results. In this regard, we note page 17 of appellants' specification, which states merely that "it is desirable that the stemlike projections 48 of the hook material 40 be releasably engaged with the disposable diaper to provide a peel strength of at least about 20 grams, desirably from about 20 to about 1500 grams and more desirably from about 30 to about 90 grams." Therefore, we are of the opinion that the recited peel strength of at least about 20 grams does not patentably distinguish the subject matter of claim 43 from the disposable diaper of Roessler.

CONCLUSION

To summarize, the examiner's rejection of claims 35, 43, 48 and 50-57 under 35 U.S.C. § 102(b) is reversed and the rejection of claim 44 as being unpatentable under 35 U.S.C. § 103(a) is

sustained. A new rejection of claims 35 and 43 under 35 U.S.C. § 103 is entered pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

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